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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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WARD KRAFT, INC.  
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EXAMINER

BATTULA, PRADEEP CHOUDARY

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/691,264

Applicant(s)

CRUM, JESSE D.

Examiner

Pradeep C. Battula

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 10-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-18 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

This action is in response to applicant's amendment filed on November 06, 2006.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 17, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lalande (U.S. 5,721,178) in view of Tighe (U.S. 4,704,310).

In regards to Claim 17, Lalande disclose an in-situ cured laminated business form, comprising; a first layer 16 of material having first 17 and second faces (not numbered; Column 2, Lines 23 – 28); a second layer 11 of material having first 15 and second faces (not numbered; Column 2, Lines 15 – 20); at least one of said first and second layers having a series of die cuts formed therein to create a plurality of removable elements 13 (layer 16; Column 2, Lines 28 – 30; Figure 1, Items 13 – 13j) and a frangible coating applied to one of said first and second faces of each of said first and second layers corresponding to an area covered by said removable elements (Column 2, Lines 9 – 30, 64 – 66; Column 3, Lines 6 – 8). The examiner considers the coating frangible since the pressed sheets can be separated.

Additionally, in response to the in-situ curing, it is not disclosed how it will be done but as long as the assembly is not moving during curing then it is in-situ. The procedures that can be executed to accomplish this goal are routine in the art.

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Furthermore, there is a product by process statement dictating "...cured in-situ by treatment energy passed through one of said first and second layers to form a laminated..." Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP 2113.

Lalande does not disclose the frangible coating is a UV curable coating.

Tighe discloses an ultraviolet curable coating 30 in a heat transferable laminate (Column 7, Lines 5 – 17; Figure 1, Item 30) cured with an H-bulb (Column 12, Lines 50 – 55). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Lalande, as modified by Good, and substitute Lalande's silicone coating and adhesive 14 with Tighe's release layer 20 and ultraviolet curable coating 30 in order to have an alternate option as ultraviolet curing is seen as a routine design choice in the art.

In regards to Claim 18, as applied to Claim 17, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

The phrases "...used as an apparel, textile tag or combination thereof. " do not further limit the claimed and are merely functional/intended use statements not defining

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any specific structure. It should be noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The only requirement is that the prior art reference be capable of said intended use. See MPEP 2114. In this case, the business form assembly of Lalande will produce the same business form that is described in Claim 17 of the application.

In regards to Claim 20, as applied to Claim 17, Tighe further discloses that the coating composition includes acrylated monomers and oligomers. Tighe discloses that the coating 20, which creates a coating composition with coating 30, includes oligomers which would also include acrylated monomers (Column 7, Lines 28 – 31).

2. Claims 1 – 6, and 10 – 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lalande (U.S. 5,721,178) in view of Good (U.S. 5,728,440) and in further view Tighe (U.S. 4,704,310).

In regards to Claim 1, Lalande discloses a composite form assembly 10, comprising; a first layer 16 having first 17 and second surfaces (not numbered), at least one of said first and second surfaces capable of receiving printing 17 (Column 2, Lines 23 – 28, Figure 1, Items 10, 16, and 17). Lalande further discloses the first layer having a series of die cuts (Column 2, Lines 36 – 37; Figure 2, Item 26 [process step]) that divide said first layer into a number of removable elements 13 (Column 2, Lines 28 – 30; Figure 1, Items 13 – 13j). Lastly, Lalande discloses that the second layer 11 having first 15 and second surfaces (not numbered) (Column 2, Lines 15 – 20) and said second

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layer is composed of a different material than said first layer (Claim 1 of Lalande); and a coating disposed between said first and second layers and provided in the area of at least said removable elements (Column 2, Line 24 – 25). The examiner considers each independent removable element as a major portion.

Lalande does not disclose the removable elements having a minor portion with said minor portion remaining with a second layer on removal of said major portion.

Good discloses, the removable elements having a major portion (not numbered) and a minor portion 15 with said minor portion remaining with a second layer 19 on removal of said major portion (Column 3, Lines 61 – 65; Figure 4, Item 19; Column 4, Line 66). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate Good's die cut into the major portions 13 of Lalande in order to allow for the tag to be attached to clothes and consumer products, as taught by Lalande (Column 2, Lines 41 – 45), without having to stitch a tag onto an item.

Lalande modified by Good does not disclose an ultraviolet curable coating. Tighe discloses an ultraviolet curable coating 30 (Column 7, Lines 5 – 17; Figure 1, Item 30) cured with an H-bulb (Column 12, Lines 50 – 55). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Lalande, as modified by Good, and substitute Lalande's silicone coating and adhesive 14 with Tighe's release layer 20 and ultraviolet curable coating 30 in order to have an alternate option as ultraviolet curing is seen as a routine design choice in the art.

Furthermore, Lalande modified by Good is capable of having one of said first and second layers to enable curing energy to pass through and with the modification of Tighe the curing energy would form a frangible bond between said first and second layers.

In regards to Claim 2, as applied to Claim 1, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. See MPEP 2114.

The phrases "...used as an apparel, textile tag or combination thereof." do not further limit the claimed and are merely functional/intended use statements not defining any specific structure. It should be noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The only requirement is that the prior art reference be capable of said intended use. See MPEP 2114. In this case, composite form assembly of Lalande altered by Good is the same composite form that is described in Claim 1.

In regards to Claim 3, as applied to Claim 1, Good discloses that the minor portion 15 is die cut (Column 3, Lines 61 – 65).

In regards to Claim 4, as applied to Claim 1, Lalande further discloses that silicone is adhered to the bottom side (not numbered) of the first layer 16 (Column 2, Line 24 – 28).

In regards to Claim 5, as applied to Claim 1, it is not disclosed in Lalande or Good that there is ultraviolet radiation treatment for curing with the use of a gallium or H-bulb.

Tighe discloses an ultraviolet curable coating 30 in a heat transferable laminate (Column 7, Lines 5 – 17; Figure 1, Item 30) cured with an H-bulb (Column 12, Lines 50 – 55). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Lalande, as modified by Good, and substitute Lalande's silicone coating and adhesive 14 with Tighe's release layer 20 and ultraviolet curable coating 30 in order to have an alternate option as ultraviolet curing is seen as a routine design choice in the art.

In regards to Claim 6, as applied to Claim 1, Lalande discloses that the first and second layers are different material and therefore possibly have different thickness. Also, Good discloses a thickness for the face stock 11 material (7 millimeters), which the tag 10 is made from, and the silicone coating (2.0 millimeters) release liner 17 (Column 4, Lines 54 – 64). Good further discloses that the assembly goes through a dryer 27 after having adhesive applied (Column 4, Lines 19 – 23). Lalande modified by Good and Tighe disclose the claimed invention except for the second layer having a thickness of no more than about 7 millimeters. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the second layer and other layers be of certain sizes, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.



In regards to Claim 10, Lalande discloses peelable laminate 13 having a frangible bond, comprising; a first layer 16 having a first thickness and having first 17 and second surfaces (not numbered) with at least one of said first and second surfaces receiving printing 17 (Column 2, Lines 23 – 28); a second layer 11 with a second thickness (Column 2, Lines 15 – 20) having first 15 and second surfaces (not numbered); a coating composition securing said first and second layers one to another upon application of a pressure treatment to form a seal, said treatment passing through one of said first and second layers to create said seal (Column 2, Lines 15 – 28); and said first layer having a series of die cuts provided therein, said die cuts producing separable tags (Column 2, Lines 28 – 30; Figure 1, Items 13 – 13j). The examiner considers each independent removable element as a major portion.

Lalande does not disclose that the two layers have different thicknesses nor does Lalande disclose that each of said tags has a minor portion, with said major portion having a surface area at least ten times greater than a surface area of said minor portion and wherein upon removal of said major portion from said first layer, said minor portion remains adhered to said first layer.

Good discloses each of said tags having a major portion and a minor portion 15, with said major portion 16 having a surface area greater than the surface area of said minor portion (Figure 1, Items 15, and 16) and wherein upon removal of said major portion from said first layer, said minor portion does not remain adhered to said first layer but is meant to be removed from the first layer (Column 3, Lines 61 – 65). Good further discloses that various changes can be made without changing the scope of the

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invention and a mere die cut that is complete and removing any hang tags would also perform the same function of removing the minor portion from the hang tag and have them remain with the second layer. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate Good's die cut, but make them full, into the major portions 13 of Lalande in order to allow for the tag to be attached to clothes and consumer products, as taught by Lalande (Column 2, Lines 41 – 45), without having to stitch a tag onto an item. In regards to the minor portion having a surface area ten times smaller than that of the major portion one only needs to reduce the size of the cut and a change in size of a component is seen as only requiring routine skill in the art.

With respect to the first and second layer having different thicknesses it is disclosed in Lalande that the first and second layers are different material and therefore possibly have different thickness. Also Good discloses a thickness for the face stock 11 material, which the tag is made from, along with the silicone coating release liner (Column 4, Lines 54 – 64). Lalande modified by Good discloses the claimed invention except for the first and second layers having different thickness. It would have been an obvious matter of design choice to have the layers be a different thickness, because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

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Lalande modified by Goode does not disclose a UV curable coating composition securing the first and second layers one to another upon application of a treatment to form a seal.

Tighe discloses an ultraviolet curable coating 30 in a heat transferable laminate (Column 7, Lines 5 – 17; Figure 1, Item 30) cured with an H-bulb (Column 12, Lines 50 – 55). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Lalande, as modified by Good, and substitute Lalande's silicone coating and adhesive 14 with Tighe's release layer 20 and ultraviolet curable coating 30 in order to have an alternate option as ultraviolet curing is seen as a routine design choice in the art.

Furthermore, Lalande modified by Good is capable of having one of said first and second layers to enable curing energy to pass through and with the modification of Tighe the curing energy would form a bond between said first and second layers.

In regards to Claim 11, as applied to Claim 10, please review the Claim 10 rejection.

In regards to Claim 12, as applied to Claim 10, Lalande discloses that the first layer 16 has a coating of silicone on the bottom surface (Column 2, Lines 24 – 28).

In regards to Claim 13, as applied to Claim 10, it is stated that removable items 13 will be printed on as they pass through a printer (Column 1, Lines 20 – 23) and it is therefore obvious that the peelable laminate is substantially planar since printers require substantially planar surfaces to be fed in order to prevent jamming and inaccuracies printing.

In regards to Claim 14, as applied to Claim 10, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

The phrases "...used to create apparel or textile tags, ski or lift tickets, entry or admission passes..." do not further limit the claimed and are merely functional/intended use statements not defining any specific structure. It should be noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The only requirement is that the prior art reference be capable of said intended use. See MPEP 2114. In this case, composite form assembly of Lalande altered by Good as applied to Claim 10 will be able to perform the intended function.

In regards to Claim 15, as applied to Claim 10, applicant has failed to disclose the criticality of the thickness of the layers. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to vary the ranges of thickness in order to create a wide variety of uses. A large range would allow for use in personal printers to industrial printers, also the range would allow for users to use a layer of material that either provides a large amount of support or smaller amount of support. This would be relevant when die cutting and for using a layer as a release ply.

In regards to Claim 16, as applied to Claim 10, neither Lalande nor Good disclose that the coating composition includes acrylated monomers and oligomers.

Tighe discloses that the coating 20, which creates a coating composition with coating 30, includes oligomers which would also include acrylated monomers (Column 7, Lines 28 – 31). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Lalande, as modified by Good, and substitute Lalande's silicone coating and adhesive 14 with Tighe's release layer 20 and ultraviolet curable coating 30 in order to have an alternate option as ultraviolet curing is seen as a routine design choice in the art.

#### ***Response to Amendment***

The 35 U.S.C. 112 2<sup>nd</sup> paragraph rejections and 35 U.S.C. 102(b) rejections have been withdrawn.

#### ***Response to Arguments***

Applicant's arguments filed on November 6, 2006 have been fully considered but they are not persuasive.

In regards to Claim 17 not being properly rejected under 35 U.S.C. 102(b), applicant has referred to the Claim 10 obviousness rejection and not the Claim 17 rejection. Please review page 8 of the response to the Non – Final Office Action dated August 1, 2006.

Applicant correctly noted that Good was to be referred upon and not Kelly and Claims 12 – 15 were inadvertently left out of the preamble but, they relied upon a Claim 10 which was included in said preamble.

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In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., frangible bond) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claims 4 and 12 as written in the Claims do not require that the coating of silicon not be part of the assembly.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation was based on the knowledge known generally.

In response to the barrier layer of Tighe, the layer is strong enough to be rolled (Column 7, Lines 13 – 17; Tighe) and still have all components in the assembly together therefore there is no reason to believe the any elements would fall away from the carrier.

In regards to arguments not addressed in this section, please review the above rejections.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Monday - Friday 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB  
Patent Examiner  
November 28, 2006

*Marcia S. Carter*  
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